paragraph 5 on page 5. The significance is that the Examiner has in essence admitted to an improper standard of consideration of the scope and content of the prior art. This substantiates Applicant's prior contention that there is no *prima facie* obviousness. For example, the Examiner states "Yamagishi (563) was not used to show distortion values of a core but to show a known dimple pattern used on golf balls." However, the prior art must be considered in its entirety for all that it fairly teaches as well as that which it does not teach and would be considered an example of instruction leading away from the purported combination. To use the -563 reference solely for the citation of a known dimple pattern used on golf balls is not only "myopic" and contrary to the statute which requires that the prior art be considered as a whole, but also as probative evidence of hindsight logic on the part of the Examiner.

Secondly, the Examiner, while admitting that Yamagishi-413 does not disclose the product of Shore D hardness of an outer layer of a core and a cover layer, contends that the reference "disclosed a range of hardness for both layers and any combination would have been suitable otherwise Yamagishi-413 would have stated as such." The Examiner is reading more into the reference than it fairly teaches. The prior art is relied upon for all that it discloses and not for that which it potentially could state. Unambiguously, the reference does not disclose or teach the fundamental concept defined by the Applicant. Rather than providing a limitation in terms of imposing on Yamagishi an obligation that he would set limits or the like, more properly the reference would be considered as one which is so open-ended that it is nothing more than an invitation to experiment without any necessary guidance or underlying logic.

Thirdly, the Examiner has misconstrued Applicant's argument concerning dimples. The Applicant did not argue that Yamagishi-413 would be construed as a golf ball devoid of dimples but rather, as set forth in the remarks beginning on the bottom of page 3 through page 4, recognized that all golf balls "clearly would have dimples otherwise the carry, for example, those values set forth in Table 3, could not be achieved by a golf ball which was perfectly round and devoid of dimples." Consequently, there was a recognition that dimples would be present but the issue here is a not whether a pattern would be present, clearly it would but rather, the specific geometry of the dimple itself within the pattern. That is, the claims here are specific to the dimple *per se*.

Fundamentally, this invention is predicated on a recognition that two entirely dissimilar properties of a golf ball when used in a specific range provide an increase in golf ball performance. There is nothing in the prior art that discloses the fundamental recognition with a combination of a particular range of V_R in a particular range of the product of Shore D hardness of the inner and outer layers. The only way in which the prior art can be recreated is by forcibly dissecting it into components to find the individual pieces, even if that could be accomplished. However, even if the individual pieces or components are found obviousness does not still exist absence of motivation or suggestion of combination. The facts that the elements in their disparate form exist does not lead to the conclusion of *prima facie* obviousness unless the artisan would have some suggestion or motivation for combination. Clearly that is not the case here. Thus, there is no *prima facie* obviousness.

Additionally, when the art is dissected in a manner in which the Examiner has done even the individual components cannot be reasonably said to meet those individual requirements of Applicant's claims.

It is incorrect to conclude as the Examiner has done that the product of each Shore D hardness in the inner and outer cover layers is in the range of 1500-4000.

Yamagishi-413 discloses an outer cover layer having a Shore D hardness in the range of 50-60. The inner cover layer has a Shore D hardness in the range of 28-68. What the -413 reference fails to disclose is the concept that the Shore D hardness of the inner and outer cover layers would be selected based on a particular combination that falls within Applicant's range. Rather, the reference defines hardness of the two layers as independent considerations. Stated differently, Yamagishi-413 simply defines materials in which the hardness would fall within individual ranges. As the Examiner can appreciate, those ranges would lead to values outside Applicant's claimed requirements. Thus, the -413 reference does not teach or suggest that the hardness of the cover layer should be selected to fall specifically within a particular range based on a product of those hardness values.

The difficulty, however, is that even if the hardness values are multiplied together, Applicant's invention is not merely restricted to the product of Shore D hardness. Rather, it contains a clear interrelationship that for specific values of hardness the value of V_R is within a particular value. There are five distinct criteria in which the product of Shore D hardness is set to different values and for each the value of V_R is thus also set.

The issue of patentability, which the Examiner in no way attempts to harmonize with the prior art, is that for any particular product of Shore D hardness given the values in Yamagishi-413 how if at all would Yamagishi vary the value of V_R even if such parameter values were taught in the prior art? The answer is that it is entirely unknown and unresolved.

This can be demonstrated by looking at the examples of Covers A-D in the reference. If the products are calculated for Cover A it would be 2200. For Cover B it would be 2320, for Cover C 2400, and for Cover D 2650. Covers A, B and C would fall within condition 2 and Cover D within condition 3. There are no examples of conditions 4 and 5.

Even if that condition is set relative to the product of Shore D, the references combined provide no reason or rationale to vary the dimple volume given differences in combined hardness. There is simply a void in the prior art with respect to that consideration.

In greater detail, the requirement then of the claims is that the prior art would then provide a teaching or a suggestion that for Covers A, B and C a dimple Type of the defined "II" would be used in accordance with Applicant's invention. This would have a V_R of approximately 0.996. A Type I could also be used having a V_R of 1.014. However, Cover D would have to have a different dimple type limited only to the Type II.

This highlights the critical defect in the Examiner's logic. At best, Yamagishi-563 defines a dimple Type III which is 0.670. It would not be used at all.

If Yamagishi's dimple Type III were used the effects would be the same as Comparative Example 1, namely the balls would have inferior flight distance in Exhibit A's so-called dropping trajectory.

The absolute problem that the Examiner cannot reconcile is why any artisan would select the dimple Type I or dimple Type II in Yamagishi-563 as opposed to dimple Type III. There is simply no rhyme or reason why any of those dimple types would be selected in the context of the -413 reference and in particular and most critically why would it be selected as a function of the hardness of the layers within particular ranges?

At best, Examiner holds that it would be obvious to use a dimple pattern which is commercially available to improve flight performance and the like. There is nothing more than a generalization to which the Applicant agrees but the statement lacks any degree of criticality with respect to this technology. The artisan would be not expected that for a particular type of Shore D hardness of the inner and outer cover layers a selection of dimple Type I or II as opposed to Type III would be used or that dimple Type II would be used in certain other conditions but not dimple Type I. The pattern is irrelevant to this consideration.

Stated differently, if Cover D was selected in Yamagishi-413, why would the artisan limit the dimple types to that of Type II in Yamagishi-563? The answer of course is that there is no answer because there is no motivation or suggestion. Consequently, it is believed that *prima facie* obviousness does not in any way exist given that fundamental deficiency in the prior art.

The rejection to claim 16 based on Hayashi in view of Yamagishi-563 is no more relevant. The same defect exists. However, there are even more reasons why Hayashi is irrelevant to this invention. The Examiner apparently does not recognize that Hayashi does not deal with a solid golf ball but rather a wound golf ball. The technologies of solid golf balls and wound golf balls are fundamentally incompatible. A wound golf ball comprises a center ball, a

thread rubber wound around and cover layers. The fact that Hayashi lacks a specific dimple pattern does not compensate for the more fundamental defect, namely that the Yamagishi-563 reference deals with a solid golf ball having fundamentally different dynamic characteristics.

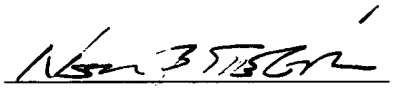
Over and above that fundamental deficiency, however, the same internally lacking teaching is present in both Hayashi and Yamagishi-563.

The Examiner should note, for example, that Yamagishi-563 itself discloses Shore D hardness of a cover outer layer. He also provides data concerning inner cover layer. Note the asterisk of the inner cover type in terms of the materials which are used. However, this reference does not in any way perceive that even with the recognition of the type of hardness used that with that data in hand a particular dimple type would be selected. This is another indication that Yamagishi-563 is totally unconcerned with the relationship between hardness of the cover layers and the dimple type which is used.

This last point bears restatement because it is germane to both rejections. That is, if Yamagishi-563 is considered in its entirety the artisan would also recognize that the reference discloses values of hardness for at least the cover outer layer. For example they are also claimed (see claim 4). If Yamagishi had any notion that there was any relationship between hardness and dimple configuration it would be expected that such a recognition would be present. None exists and the Examiner's analysis cannot provide the logic which is clearly missing in the prior art. As such then it is respectfully contended that the Examiner's reliance on the prior art is deficient and that no *prima facie* obviousness exists. Reexamination and reconsideration is thus requested.

Should the Examiner have any questions he is requested to contact the undersigned attorney of record at the location listed below.

Respectfully submitted,



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